



MAY 09 2001

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McDermott, Will & Emery
600 13th Street, N.W.
Washington, DC 20005-3096

In re Application of WELLS et al
U.S. Application No.: 09/355,268
Int. Application No.: PCT/GB98/00226
Int. Filing Date: 27 January 1998
Priority Date: 27 January 1997
Attorney Docket No.: 50060-034
For: AUDIO COMPRESSION

DECISION

This is in response to applicants' "Request for Reconsideration of Holding of Abandonment and Petition for Revival" filed 13 April 2000, which is being treated as a petition to withdraw a holding of abandonment based on failure to receive an office action under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 27 January 1998, applicants filed international application PCT/GB98/00226, which claimed priority of an earlier United Kingdom application filed 27 January 1997. A copy of the international application was communicated to the USPTO from the International Bureau on 30 July 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 July 1998, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 27 July 1999.

On 27 July 1999, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, an authorization to charge the basic national fee required by 35 U.S.C. 371(c)(1).

On 19 August 1999, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 05 April 2000, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the present application is abandoned based on applicants' failure to respond to the Notification of Missing Requirements mailed 19 August 1999.

On 13 April 2000, applicants filed the present petition. The petition states that a search of all docketing systems revealed that the Notification of Missing Requirements was never received by applicants. The petition further states that it is accompanied by a copy of a docketing department docket record for the present application and by a copy of an applications department docket record showing items due on 19 September 1999.

DISCUSSION

According to the Official Gazette at 1156 OG 53 and MPEP 711.03(c), a petition to withdraw a holding of abandonment based on failure to receive an Office communication must include: (1) a statement by the practitioner that the Office communication was not received by the practitioner, (2) a statement by the practitioner that he searched the application file jacket and docket records and that the search indicates that the Office communication was not received, and (3) a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

With regard to item (1) above, applicants' representative has provided the required statement.

With regard to item (2) above, although the petition states that docket records were searched, applicants' representative has not provided a statement that the application file jacket was searched and that such search indicated that the Notification of Missing Requirements was not received.

With regard to item (3) above, applicants' representative has submitted a docketing department docket listing for the present application 09/355,268 which shows no entry for a Notification of Missing Requirements. Applicants' representative has also submitted an applications department docket record showing items due on 19 September 1999. Although the applications department docket record does not contain an entry for a Notification of Missing Requirements due on 19 September 1999, the petition does not sufficiently explain the scope of the applications department docket record. In order to satisfy the evidentiary requirements necessary for a withdrawal of the holding of abandonment, applicants should furnish a docket record listing the responses due to the USPTO on 19 September 1999 for all cases of the representative's firm (or for all cases of applicants' representative if a complete firm docket record does not exist.) It is unclear from the petition whether the applications department docket record includes responses due for all cases handled by the representative's firm.

CONCLUSION

For the reasons above, the petition to withdraw the holding of abandonment is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181" No petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Bryan Tung
PCT Legal Examiner
PCT Legal Office



Boris Milef
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459